

Appl. No. 09/934,549

JUL 30 2008

Amdt. dated 07/30/2008

Attorney Docket No.: TS01-285

Response to Office Action of 05/02/2008

N1085-90132

REMARKS/ARGUMENTS

Claims 1-11 were previously pending in this application with claims 4-8 having been most recently withdrawn from consideration. Each of pending claims 1-3 and 9-11 has been rejected.

Claim 1 is amended in this paper. Applicant respectfully submits that each of pending claims 1-3 and 9-11 is in allowable form. Withdrawn claim 6 is also amended for editorial purposes.

I. Claim Rejections – 35 U.S.C. § 103

In paragraph 5 of the subject Office action, claims 1, 3, 9, and 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over USP 6,524,057 to **Park** in view of USP 6,454,512 to **Weiss**, USP 5,749,589 to **Hopkins et al.**, Germany 3917874 to **Selbert**, USP 4,293,075 to **Veralrud**, USP 6,421,113 to **Armentrout**, and USP 5,873,585 to **Engelking**. Moreover, in paragraph 6 of the subject Office action, claims 2 and 11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over **Park**, as modified, and further in view of USP 4,999,671 to **Iizuka**. Applicant respectfully submits that each of these claim rejections is overcome for reasons set forth below.

Applicant also takes this opportunity to thank the Examiner for the commentary provided in the *Response to Arguments* section, in particular paragraphs 8-10, of the subject Office action.

Briefly and in summary and as previously stated, it is a combination of limitations that are non-obvious under the conditions of 35 U.S.C. § 103, even though some or all of the features of the invention may be separately known. Applicant submits that a holding that combination claims are unpatentable based on locating similar elements in other documents is improper, would be contrary to statute and would defeat the congressional purpose in enacting title 35. Smithkline Beecham, Inc. v. Helena Labs. Corp., 859 F.2d 878, 8 USPQ2d 1468 (Fed. Cir. 1988). This is especially true when

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relying upon multiple documents from various fields of art. The hindsight reasoning employed in using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result. Applicant respectfully submits that the Examiner has not shown some suggestion or motivation, before the invention itself, to make the claimed combination as required in Ruiz v. AB Chance Co., 357 F.3d 1270, 69 USPQ2d 1686, 1690 (Fed. Cir. 2004). Indeed, Applicant submits that the Examiner has not demonstrated that it would be obvious to combine features to produce the claimed combination under ANY theory of obviousness required under the conditions of 35 U.S.C. § 103.

The Examiner has had to rely upon multiple documents from various fields of art - some directed to wheeled carts and others directed to stationary storage units for various purposes - to pick and choose certain features and/or to remove or reconfigure other features, in order to arrive at the claimed combination of features.

The unrelated elements from the different disclosures do not render the combination thereof obvious, as alleged by the Examiner. The Examiner impermissibly combined the references. Applicant respectfully submits that the Examiner has simply and impermissibly relied upon hindsight to arrive at the determination of obviousness. "It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teaching of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention". *In re Fitch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) at USPQ2d 1783-84 (quoting *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

The Examiner is not free to pick bits and pieces from the prior art and, with the hindsight benefit of the Applicant's disclosure, attempt to reconstruct the invention. Orthopedic Equipment, Inc. v. U.S., 217 U.S.P.Q 193, 199 (Fed Cir 1983). Yet, in

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combining the multiple documents, this is what has been done. In response to the Examiner's statement in paragraph 10 of the subject Office Action that, "reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention", Applicant submits that the excessive number of references used by the Examiner in this case is certainly indicative that the Examiner certainly has impermissibly picked and chosen bits and pieces from multiple references, using the claimed invention as a roadmap. Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness.

Applicant respectfully traverses the Examiner's comment, in the *Response To Arguments* section, that the motivation to combine references is satisfied by simply using the triggered clause "in order to." With respect to a primary reference, it must be shown that there is a suggestion, motivation or need to use a feature from another reference *in order to* make an improvement or otherwise modify the primary reference. A feature in a secondary reference does not satisfy this requirement of being used "in order to" accomplish something with respect to a primary reference, if the feature from the secondary reference is inconsistent with the primary reference. It is intuitive that a feature in a secondary reference is used "in order to" carry out a function in the second reference but the test is whether this feature of the secondary reference would be, or even could be used "in order to" serve a purpose in the primary reference. Applicant respectfully submits that the Examiner has not fulfilled this requirement.

Applicant points out that independent claim 1 has been amended and now recites that the "platform" is "planar". In particular, claim 1 now recites:

- (ii) a platform being substantially planar and having a first and a second surface opposite said first surface, said wheels being attached to said first surface of said platform;
- (iii) shock absorbers, being mounted on the second surface of said platform;

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(b) an upper portion disposed over said shock absorbers,
said shock absorbers forming an interface between said
platform and said upper portion,

The Examiner has conceded that the Park reference is deficient of many of the aspects of the claimed invention recited in claim 1. For example, in the sentence bridging pages 3 and 4, the Examiner concedes that Park fails to disclose shock absorbers.

The Office Action then relies upon the Weiss reference and provides "Weiss teaches the idea of having shock absorbers 32 being mounted on the second surface of a platform in order to prevent damage to the wafers due to jolting of the cart during transporting of the wafers". Referring to claim 1, the claimed invention provides shock absorbers being mounted on the second surface of the platform with an upper portion disposed over the shock absorbers, the shock absorbers forming an interface between the platform and the upper portion.

Weiss, in sharp contrast, provides shock absorbers 32 that are disposed above a bar, but Weiss's shock absorbers 32 do not form an interface between anything, much less between a platform and an upper portion of the cart. The upper portion of the cart is coupled below the shock absorbers 32 as shown in FIGS. 5, 6 and 7 of Weiss and nothing appears to be disposed above shock absorbers 32 such as would enable shock absorbers 32 to serve as an interface between a subjacent and superjacent feature. Weiss therefore does not provide the claimed shock absorbers and does not make up for this admitted deficiency of Park.

Now turning to Hopkins, an airline baggage cart, the Office action states "Hopkins et al. further teaches the idea of providing shock absorbers 76 being disposed between a platform 35 and an upper portion 21, such as shown in FIG. 4, in order to absorb vibration between the platform 35 and the upper portion 21". Amended claim 1 recites that the wheels are attached to a first surface of the substantially planar platform

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and shock absorbers are mounted on the second, opposed surface of the substantially planar platform.

Hopkins does not provide the feature of a shock absorber disposed on the opposite side of a planar platform, with respect to the wheels.

Both the pads 76 and wheels of Hopkins are joined to angle bracket 79, not to opposed surfaces of a planar platform. Hopkins therefore does not provide the shock absorber feature as recited in claim 1 and Hopkins therefore does not make up for the admitted deficiency of Park. Hopkins, moreover, is directed to nonalagous art, namely an airline baggage cart which is pulled by a vehicle over a tarmac and Applicant respectfully submits that one would not modify Park's vehicle for transporting semiconductor containers throughout a delicate factory environment by looking to such an airline baggage cart.

Moreover, again referring to the Examiner's statement of "in order to" as stated in the *Response To Arguments* section, one would not use the shock absorber of Weiss or Hopkins to attempt to modify Park because the Park reference could not accommodate either shock absorber. An examination of Park shows conductive body 110 and casters 105 (wheels) attached to the bottom of conductive body 110. The wheels are simply not attached to a platform that could also have a shock absorber attached thereto. As such, in addition to the previous comments supporting that the language of claim 1 provides a shock absorber that is distinguished from any shock absorber provided in Weiss or Hopkins, Applicant also respectfully submits that the Examiner has not and cannot show that one would attempt to modify Park by adding a shock absorber of Weiss or Hopkins. This is so because the Park device could not accommodate either shock absorber without a complete re-engineering of the Park device. With respect to the Examiner's statement, in the sentence bridging pages 4 and 5, that *"it would have been obvious to modify the structure of Park by providing the component cart with shock absorbers (in place of the corner portions) being mounted on the second surface of the platform ... as taught by Weiss, providing shock absorbers being disposed between the platform and*

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the upper portion Applicant respectfully points out that there is no platform or upper portion of Park that might be considered for having a shock absorber added thereto.

None of the other references teach the claimed shock absorber feature and therefore claim 1 is distinguished from the references for at least these reasons.

Now with respect to the Armentrout reference, the Office action relies upon Armentrout for providing cushioning units. Claim 1 recites the feature of *cushioning units arranged over the surface of said component box support units*. In particular, the Office action alleges that "Armentrout teaches the idea of providing cushioning units over the surface of the component box support units in order to avoid damage to the articles when inserting or removing *from the upper portion*", emphasis added, subject Office action, page 4, lines 18-20.

As indicated by the highlighted section of the Examiner's comment, *supra*, the Examiner appears to rely on Armentrout for a cushioning unit that would aid in cushioning units being inserted into or taken out of the upper unit which would be SMIF pod 100. Applicant first points out that the term "cushioning unit", the term "cushioning", or the term "cushion" does not appear anywhere in the Armentrout reference. An examination of SMIF pod 100 shows reticles 300 resting upon reticle supports 202. The reticle support feature 202 upon which reticle 300 rests, however, would not be considered a cushioning unit as they are formed of polycarbonate plastic impregnated with carbon fibers, clearly a rigid and a non-cushioning material. Armentrout therefore does not provide a cushioning unit, much less the cushioning unit as recited in independent claim 1. Independent claim 1 is therefore distinguished from the references of record for at least this reason.

In view of the above comments, independent claim 1 is therefore distinguished from Park in view of Weiss, Hopkins, Seibert (Germany), Veralrud, Armentrout and Engelking and therefore the rejection of claim 1 under 35 U.S.C. § 103(a) in view of these references, should be withdrawn. Claims 2-3 and 9-11 depend from claim 1 and

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are therefore similarly distinguished. Therefore, the rejection of claims 1, 3 and 9-10 under 35 U.S.C. § 103(a) as being unpatentable over Park in view of Weiss, Hopkins, Seibert (Germany), Veralrud, Armentrout and Engelking, should be withdrawn.

In paragraph 8 of the subject Office action, claims 2 and 11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Park as modified and further in view of USP 4,999,671 to Iizuka. These claim rejections are overcome for reasons set forth below.

As above, independent claim 1 is distinguished from Park as modified. Claims 2 and 11, which depend from claim 1, are similarly distinguished from Park as modified. The Iizuka reference has apparently been relied upon for providing reticle boxes with reticles therein, but Iizuka does not make up for the above-stated deficiencies of Park in view of the secondary references. Because Iizuka does not make up for the above-stated deficiencies of Park in view of the secondary references, independent claim 1 and therefore also dependent claims 2 and 11 are distinguished from Park, as modified and as applied to claim 1, and further in view of Iizuka. The rejection of claims 2 and 11 as being unpatentable over Park as applied to claim 1 and further in view of Iizuka, should be withdrawn.

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CONCLUSION

Based on the foregoing, each of pending claims 1-3 and 9-11 is in allowable form and the application in condition for allowance, which action is respectfully and expeditiously requested.

- 5 The Assistant Commissioner for Patents is hereby authorized to charge any fees necessary to give effect to this filing and to credit any excess payment that may be associated with this communication, to Deposit Account 04-1679.

- 10 Dated: July 30, 2008



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